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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,091	07/14/2003	William R. Schmeling	19596-0541 (45738-286749)	8595
23370	7590	11/02/2006	EXAMINER	
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			HYUN, PAUL SANG HWA	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,091

Applicant(s)

SCHMELING, WILLIAM R.

Examiner

Paul S. Hyun

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

REMARKS

Claims 1-8 and 16-23 are pending. Applicant cancelled claims 9-15, amended claims 1-8 and 16-20, and added new claims 21-23 in response to the previous Office action. The amendments made to the claims have changed the scope of all amended claims. The claims that were withdrawn in accordance to the restriction requirement imposed on 04/19/06 have been rejoined because the non-elected claims have been amended such that they now depend from the elected claims.

The claim objections cited in the previous Office action are withdrawn in light of the amendments.

The rejection of claims 19 and 20 under 35 U.S.C 112 2nd paragraph has been withdrawn in light of the amendments.

Double Patenting

Applicant is advised that should claim 3 be found allowable, claim 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1 and 16** are rejected under 35 U.S.C. 102(b) as being anticipated by Rohr (US 5,445,971).

Rohr discloses a test kit comprising a reaction vessel with magnetically-attractable label disposed thereon for conducting binding assays (see lines 45-58, col. 2), wherein the reaction vessel can be a test strip (see line 17, col. 14). The labels are physically bound to a location of the test strip such that the test strip moves and adopts a specific spatial orientation when the test strip is exposed to a magnetic field (see lines 36-68, col. 19 and Fig. 4).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-3, 16 and 17** are rejected under 35 U.S.C. 102(e) as being anticipated by Hagen et al. (US 6,872,358 B2).

Hagen et al. disclose a test strip dispenser wherein the test strips to be dispensed are rectangular and flat (see lines 40-50, col. 5 and Fig. 2A). The reference discloses that in order to dispense a test strip, the dispenser utilizes a magnet to

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engage a magnet means that is disposed at an end or an edge of the test strip to be dispensed and moves the test strip away from the stack of test strips housed within the dispenser (see lines 1-23, col. 15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **4 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen et al. in view of Hegedus (US 3,384,093).

Hagen et al. do not disclose that the magnetic means attached to each test strip is in the form of a tape.

Hegedus et al. disclose a filing card cabinet in which the filing cards are withdrawn from the filing cabinet by means of a magnetic rod 8 that engages a metallic strip 6 affixed to each filing card.

In light of the disclosure of Hegedus et al., it would have been obvious to one of ordinary skill in the art to make the magnetic means affixed to the test strips disclosed by Hagen et al. in the form of metallic strips since metallic strips are thin and are well suited for attaching to flat articles.

It also would have been obvious to one of ordinary skill in the art to form the metallic strip out of iron since iron is abundant and well-known to be responsive to magnetic fields.

Claim **18** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen et al. in view of Caladine (GB 2 170 780 A).

Hagen et al. do not disclose the step of counting the test strips as they move in response to the magnetic field.

Caladine discloses a dispenser comprising a counter 41 that counts the number of times the dispenser has dispensed an article (see lines 30-38, page 1). The reference discloses that it is desirable to count the number of times a dispenser has dispensed an article for the purposes of detecting theft or malfunction (see lines 8-25, page 1).

In light of the teachings of Caladine, it would have been obvious to one of ordinary skill in the art to provide the dispenser disclosed by Hagen et al. with a counter such that the dispenser counts the number of times a test strip has been dispensed so that theft or malfunction can be detected.

Claims **19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen et al. in view of Caladine as applied to claim 18 above, and further in view of Nambu (US 5,444,749).

Neither Hagen et al. nor Caladine disclose that the counting is accomplished by monitoring the changes in the weight of the container as the test strips are dispensed.

Nambu discloses an article dispensing system comprising a weight meter 9 that measures the weight of the articles dispensed into a container 8. The weight meter communicates with an operation unit 14 that calculates the number of articles dispensed based on the weight of articles dispensed and the weight of each individual article (see lines 4-13, col. 8).

In light of the teachings of Nambu, it would have been obvious to one of ordinary skill in the art to provide the modified dispenser disclosed by Hagen et al. and Caladine with a weight meter such that the weight meter monitors the changes in the weight of the dispenser in order to provide another means for counting the number of test strips dispensed by the dispenser.

Claims **1, 6-8, 16 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over van Rijckevorsel et al. (US 4,578,716) in view of Casner (US 3,623,603).

Van Rijckevorsel et al. disclose a test strip as well as a method for sorting out faulty test strips from the superior test strips during the manufacturing process. The reference discloses that faulty test strips can be sorted out from the superior test strips by marking them and manually removing them (see lines 17-20, col. 8). The reference differs from the claimed invention in that the reference does not disclose the use of a magnetic field to sort the test strips.

Casner discloses that it is well known in the art to separate defective articles from non-defective articles by labeling the defective articles with a magnetic label and

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applying a magnetic field to the entire batch to isolate the defective articles (see lines 1-20, col. 2). The reference discloses that this method eliminates human error associated with manual sorting.

In light of the disclosure of Casner, it would have been obvious to one of ordinary skill in the art to mark the faulty test strips disclosed by van Rijckevorsel et al. with magnetic labels and separate the faulty test strips from the superior test strips by means of a magnetic field in order to eliminate human error associated with manual sorting.

Claim **21** is rejected under 35 U.S.C. 103(a) as being unpatentable over van Rijckevorsel et al. in view of Casner as applied to claims 1, 6-8, 16 and 18, and further in view of Werderitch et al. (US 4,387,064).

Neither van Rijckevorsel et al. nor Casner disclose the step of counting the test strips.

Werderitch et al. disclose a method for sorting defective articles from non-defective articles (see lines 1-10, col. 2). The method comprises counting the number of defective articles produced during the manufacturing process in order to determine the efficiency of the manufacturing process.

In light of the disclosure of Werderitch et al., it would have been obvious to one of ordinary skill in the art to provide the step of counting the number of defective test strips to the modified method disclosed by van Rijckevorsel et al. and Casner so that manufacturing efficiency can be determined.

Claims **22 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over van Rijckevorsel et al. in view of Casner and Werderitch et al. as applied to claim 21, and further in view of Bonnet (US 5,896,999).

None of van Rijckevorsel et al., Casner or Werderitch et al. disclose counting test strips by monitoring changes in the gross weight of the test strips as they are moved.

Bonnet discloses a method for sorting articles into bags in which the articles to be sorted are counted based on the change in the weight of the bags (see claim 13).

In light of the disclosure of Bonnet, it would have been obvious to one of ordinary skill in the art to count the number of defective test strips based on the weight of the defective test strips moved into or out of container rather than actually counting the test strips. Articles that are small or numerous in number are easier to quantify by measuring the weight of the bulk rather than counting individual articles.

Response to Arguments

Applicant's arguments with respect to claims 1 and 6-8 as being obvious over van Rijckevorsel et al. in view of Landsdorp et al. are persuasive. Consequently, the rejection has been withdrawn. However, upon further consideration and search, a new ground of rejection has been made.

Applicant's arguments with respect to the art rejection of claims 1, 6 and 16 as being anticipated by Rohr have been fully considered but they are not persuasive. The amended claims are still anticipated by Rohr. Rohr discloses magnetically-attractable label disposed on a test strip. The labels are physically bound at multiple locations of

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the test strip such that the test strip moves and adopts a specific spatial orientation when the test strip is exposed to a magnetic field (see lines 36-68, col. 19 and Fig. 4).

Applicant's arguments with respect to the art rejection of claims 1, 16 and 17 as being anticipated by Hagen et al. have been fully considered but they are not persuasive. The amended claims are still anticipated by Hagen et al. Hagen et al. disclose a test strip comprising magnet means that is disposed at a location of the test strip, the location being an end or an edge of the test strip (see lines 1-23, col. 15).

Applicant's arguments with respect to the art rejection of claim 18 as being obvious over Hagen et al. in view of Caladine have been fully considered but they are not persuasive. Applicant's argument that the test strip disclosed by Hagen et al. does not comprise a magnetically attractive material at one or more locations of the strip has been already addressed. With respect to Applicant's arguments regarding the Caladine reference, Applicant argues that the magnet taught by Caladine does not operate in the same manner as the claimed invention. However, the Caladine reference was relied upon for its disclosure of a counter that counts the number of times a dispenser has dispensed an article, not a magnetic means and the manner in which the magnetic means causes the strips to move. If a counter such as the one disclosed by Caladine was incorporated into the dispenser disclosed by Hagen et al., the modified dispenser would be able to count the test strips as each test strip is dispensed wherein the movement of the test strip being dispensed is caused by a magnetic means.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul S. Hyun whose telephone number is (571)-272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSH
10/25/06


Jill Warden
Supervisory Patent Examiner
Technology Center 1700